

REMARKS

Applicant has studied the Office Action dated June 3, 2005 and has made amendments to the claims. Claims 1-29 are pending. Claims 1 and 17 are independent claims. Claims 2, 14 and 20 have been amended. No new matter has been entered. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Specification

An amendment has been made to the specification at page 1 in order to claim priority to the foreign application. No new matter has been added as the amendments have support in the specification and drawings as originally submitted.

§ 112 Rejection

The Examiner rejected claims 2-6 and 20-29 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner indicated that use of the word “preferably” in claim 2 renders the claim indefinite. Furthermore, the Examiner indicated that claim 14 recites the trademark/tradenames “Epoxy” and “Teflon.” Moreover, the Examiner asserted that there is no antecedent basis for “the signal electrode” and “the ground electrode” in claim 20.

With this paper, claim 2 has been amended to delete the word “preferably” and claim 14 has been amended to delete the words “Epoxy” and “Teflon.” Furthermore, claim 20 has been amended to recite “the signal electrodes” and “the ground electrodes.”

It is respectfully submitted that the grounds for rejection have been overcome with respect to claims 2, 14 and 20. It is further respectfully submitted that the grounds for rejection have also been overcome with respect to claims 3-6 and 21-29, which depend from, respectively, claims 2 and 14. It is respectfully requested that the objection be withdrawn.

§ 102 Rejections

Claims 1-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by Honjo (U.S. Patent No. 5,404,581). This rejection is respectfully traversed.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 has(Fed. Cir. 1991).

It is respectfully noted that the Examiner asserts, at paragraph 4 of the Office action, that Honjo discloses “in figures 3 and 4” that “the antenna 31, the low noise amplifier 34, and the phase shifter 37 are formed on one high resistance substrate.” Applicant respectfully disagrees with the Examiner’s interpretation of Honjo.

It is respectfully noted that reference number “1” in Honjo is disclosed as the “semi-insulation GaAs substrate” in FIG. 2. Col. 2, ll. 46-48. It is further respectfully noted that Honjo discloses a “GaAs chip 44” in FIG. 3 and a “GaAs substrate 53” in FIG. 4. For purposes of this discussion, Applicant assumes that the Examiner is asserting the “GaAs chip 44” in FIG. 3 of Honjo and the “GaAs substrate 53” in FIG. 4 of Honjo as analogous to the “one high resistance substrate” recited in independent claims 1 and 17 of the present application.

It is respectfully noted that the present invention is directed to the disadvantages of the prior art “semiconductor process” for fabricating the “phase shifter.” Specification at page 3, line 7 to page 4, line 7. It is respectfully submitted that Honjo is directed to the same prior art process that the present invention improves upon. It is further respectfully submitted that Honjo fails to disclose the high resistance substrate recited by independent claims 1 and 17.

It is respectfully noted that Honjo is directed to “a semiconductor device ...utilizing a compound semiconductor and a silicon semiconductor” in which “a microwave-millimeter wave circuit [is] provided on a ... semi-insulation compound semiconductor substrate. Col. 1, ll. 7-10 and 61-64. It is further respectfully noted that Honjo discloses that “GaAs is ... a compound semiconductor substrate.” Col. 3, ll. 44-46. Moreover, it is respectfully submitted that nowhere in Honjo is the “semi-insulation GaAs substrate” in FIG. 2, the “GaAs chip 44” in FIG. 3 or the

“GaAs substrate 53” on FIG. 4 disclosed as a high resistance substrate, as recited in independent claims 1 and 17.

It is respectfully asserted that independent claims 1 and 17 are allowable over the cited reference. It is further respectfully asserted that claims 2-16, which depend from claim 1, and claims 18-29, which depend from claim 17, also are allowable over the cited reference.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1-29 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

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By: 

Richard C. Salfelder
Registration No. 51,127
Attorney for Applicant

Customer No. 035884

801 S. Figueroa Street, 14th Floor
Los Angeles, California 90017
Telephone: 213-623-2221
Facsimile: 213-623-2211